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EXAMINER	
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ART UNIT	PAPER NUMBER
2894	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,036	AMOH ET AL.	
	Examiner	Art Unit	
	ALEXANDER BELOUSOV	2894	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 & 6-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the amendment filed on 10/09/2008. Currently, claims 1-4 & 6-13 have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-4, 6-10 & 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over (JP-2003-209286) by Kitano in view of Silicon Processing for VLSI Era Volume 1 by Wolf et al ("Wolf") and further in view of (US-6689498) by Shinosawa et al ("Shinosawa").

Regarding claim 1, Kitano discloses in FIG. 3 and related text, **e.g.,** (machine translation of the publication has been included) a semiconductor light-emitting element mounting member comprising: a substrate (111); and a metal film (107) formed on a surface of said substrate, formed from Ag, Al, or an alloy containing said metals, and functioning as an electrode layer for mounting at least one of a semiconductor light-emitting element (100) and a reflective layer for reflecting light from a semiconductor light-emitting element.

Kitano does not disclose the thickness of the metal film is 0.5-3 .mu.m and crystal grains of said metal or alloy forming said metal film have a particle diameter along a surface plane of said metal film is no more than 0.5 .mu.m and said surface of said metal film has a center-line average roughness Ra of no more than 0.1 .mu.m.

Wolf teaches, **e.g.**, the thickness of the metal film is 0.5-3 .mu.m (page 435; "thickness range of 500-1500 nm") and crystal grains of said metal or alloy forming said metal film have a particle diameter along a surface plane of said metal film is no more than 0.5 .mu.m and said surface of said metal film has a center-line average roughness Ra of no more than 0.1 .mu.m (pages 106-107 describe the vapor deposition process; bottom of page 106: smaller grains are result of lower substrate temperature; top of page 107: smaller grains are result of higher deposition rates; these are the two methods stated by applicant in his disclosure for achieving his particle diameter and roughness specs; hence, these results are **inherent** in the application of Wolf's teaching by applicant's own disclosure).

NOTE: the Applicant states one more factor which **may** affect particle diameter and roughness specs: roughness of the substrate; however, Applicant discloses that this is not a strict requirement (page 16: "**may** not be possible"). However, in order to eliminate any doubt, an explicit teaching for the roughness of the substrate is provided below.

Shinosawa discloses in FIG. 3 and related text, **e.g.**, a surface roughness of the substrate is 0.05 .mu.m or less (see column 7, lines 30-40; please note that the Applicant discloses a surface roughness of the substrate that is 0.08 .mu.m or less for the substrate that meets the claim limitations (page 37, top table, "Seventh example")).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Kitano with the thickness of the metal film is 0.5-3 .mu.m and crystal grains of said metal or alloy forming said metal film have a particle diameter along a surface plane of said metal film is no more than 0.5 .mu.m and said surface of said metal film has a center-line average roughness Ra of no more than 0.1 .mu.m and a surface roughness of the

substrate is 0.05 .mu.m or less, in order to simplify the manufacturing process, by using conventional & well-known materials (Wolf, page 435, Table 11-1) of conventional & well-known thickness for use as a conductor of electricity that have low resistivity (Wolf, page 435), to further increase the reflection factor of the thin film (see Kitano, paragraph 8: raising reflection factor is a stated goal of the invention; also see Shinosawa, column 1, lines 50-65 and column 5, lines 19-26; "mirror finish" is one of Shinosawa's goals) and in order to improve metal film deposition accuracy (see Shinosawa, column 7, lines 30-40), respectively.

Please note that applying a known technique (Wolf and Shinosawa's teachings for reducing the grain size and surface roughness of a thin film) to a known device ready for improvement (device of Kitano) to yield predictable results (grain size and surface roughness of thin film are reduced) is considered to be obvious (KSR International Co. v. Teleflex Inc., 550 U.S.-, 82 USPQ2d 1385).

Regarding claim 2, Kitano discloses in FIG. 3 and related text, **e.g.**, an adhesion layer (110) and a barrier layer (109) are formed, in sequence, on said substrate, with said metal film being formed on said barrier layer.

Regarding claims 3, 4 & 6, the combined device of Kitano, Wolf and Shinosawa discloses in cited figures and related text, **e.g.**, said metal film is formed as an alloy of at least one of Ag and Al and other metal (Wolf, page 435, Table 11-1, "Aluminum / 4% Copper), a proportional content of said other metal being 0.001-10 percent by weight, wherein said other metal is at least one type of metal selected from a group consisting of Cu, Mg, Si, Mn, Ti, and Cr.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Kitano with said metal film is formed as an alloy of at least one of Ag and Al and other metal, a proportional content of said other metal being 0.001-10 percent by weight, wherein said other metal is at least one type of metal selected from a group consisting of Cu, Mg, Si, Mn, Ti, and Cr as taught by Wolf, in order to improve the film's resistance to electromigration (page 435).

Regarding claims 7 & 8, the combined device of Kitano, Wolf and Shinosawa discloses in cited figures and related text, **e.g.**, a thermal expansion coefficient of said substrate (50) is 1.times.10.sup.-6/K-10.times.10.sup.-6/K and a thermal conductivity of said substrate is at least 80 W/mK (Shinosawa, Title "Aluminum Nitride"; by Applicant's admission on page 12, lines 11-12, "AlN" meets the above claim limitations).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Kitano, Wolf and Shinosawa with a thermal expansion coefficient of said substrate is 1.times.10.sup.-6/K-10.times.10.sup.-6/K and a thermal conductivity of said substrate is at least 80 W/mK, in order to simplify the processing steps of making the device, by taking an advantage of a conventional substrate material with an excellent thermal conductivity (see column 1, lines 44-48).

Regarding claim 9, Kitano discloses in FIG. 3 and related text, **e.g.**, a semiconductor light-emitting element mounting member according to claim 1 wherein said semiconductor light-emitting element mounting member is a flat submount (see FIG. 3).

Regarding claim 10, Kitano discloses in FIG. 3 and related text, **e.g.**, a semiconductor light-emitting element (100) mounted thereto.

Regarding claims 12 & 13, the combined device of Kitano, Wolf and Shinosawa discloses in cited figures and related text, **e.g.**, said substrate is an insulative ceramic that is selected from a group consisting of AIN, Al2O3, SiC, Si3N4, BeO, BN, and insulative Si (see Title; "Aluminum Nitride").

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Kitano, Wolf and Shinosawa with said substrate is an insulative ceramic that is selected from a group consisting of AIN, Al2O3, SiC, Si3N4, BeO, BN, and insulative Si, in order to simplify the processing steps of making the device, by taking an advantage of a conventional substrate material with an excellent thermal conductivity (see Shinosawa, column 1, lines 44-48).

5. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over (JP-2003-209286) by Kitano, Silicon Processing for VLSI Era Volume 1 by Wolf et al ("Wolf") and (US-6689498) by Shinosawa et al ("Shinosawa") as applied to claim(s) above, and further in view of (US-2004/0004435) by Hsu.

Regarding claim 11, Kitano, Wolf and Shinosawa disclose substantially the entire claimed structure, as recited in claims 1 & 10, except the output of said semiconductor light-emitting element is at least 1 W.

Hsu teaches in FIG. 2 and related text, **e.g.**, the output of said semiconductor light-emitting element is at least 1 W (paragraph 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Kitano, Wolf and Shinosawa with the output of said

semiconductor light-emitting element is at least 1 W, in order to use the device in an application that requires high brightness (see Hsu, paragraph 9).

6. **Claims 1-4, 6-10 & 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silicon Processing for VLSI Era Volume 1 by Wolf et al ("Wolf") in view of (JP-2003-209286) by Kitano and further in view of (US-6689498) by Shinosawa et al ("Shinosawa").

Regarding claim 1, Wolf discloses, **e.g.**, a substrate (Fig. 4-1); and a metal film formed on a surface of said substrate, formed from Ag, Al, or an alloy containing said metals (see Table 11-1); wherein the thickness of the metal film is 0.5-3 .mu.m (page 435; "thickness range of 500-1500 nm") and crystal grains of said metal or alloy forming said metal film have a particle diameter along a surface plane of said metal film is no more than 0.5 .mu.m and said surface of said metal film has a center-line average roughness Ra of no more than 0.1 .mu.m (pages 106-107 describe the vapor deposition process; bottom of page 106: smaller grains are result of lower substrate temperature; top of page 107: smaller grains are result of higher deposition rates; these are the two methods stated by applicant in his disclosure for achieving his particle diameter and roughness specs; hence, these results are **inherent** in the application of Wolf's teaching by applicant's own disclosure).

Wolf does not disclose a semiconductor light-emitting element mounting member comprising: a metal film functioning as an electrode layer for mounting at least one of a semiconductor light-emitting element and a reflective layer for reflecting light from a semiconductor light-emitting element.

Kitano discloses in FIG. 3 and related text (machine translation of the publication has been included) , **e.g.**, a semiconductor light-emitting element mounting member comprising: a

metal film (107) functioning as an electrode layer for mounting at least one of a semiconductor light-emitting element (100) and a reflective layer for reflecting light from a semiconductor light-emitting element.

NOTE: the Applicant states one more factor which **may** affect particle diameter and roughness specs: roughness of the substrate; however, applicant discloses that this is not a strict requirement (page 16: "**may** not be possible"). However, in order to eliminate any doubt, an explicit teaching for the roughness of the substrate is provided below.

Shinosawa discloses in FIG. 3 and related text, **e.g.,** a surface roughness of the substrate is 0.05 .mu.m or less (see column 7, lines 30-40; please note that the Applicant discloses a surface roughness of the substrate that is 0.08 .mu.m or less for the substrate that meets the claim limitations (page 37, top table, "Seventh example")).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Wolf with a semiconductor light-emitting element mounting member comprising: a metal film functioning as an electrode layer for mounting at least one of a semiconductor light-emitting element and a reflective layer for reflecting light from a semiconductor light-emitting element a surface roughness of the substrate is 0.05 .mu.m or less, in order to use the device in an application which requires a semiconductor light-emitting element mounting member, a semiconductor light-emitting element, and in order to improve metal film deposition accuracy (see Shinosawa, column 7, lines 30-40), respectively.

Please note that combining prior art elements (Wolf's teaching of thin film, Kitano's teaching of a mounting member and light-emitting element and Shinosawa's teaching of substrate roughness) according to known methods (mounting the device on top of a film is

known, according to Kitano; method of reducing the roughness of substrate is explicitly taught by Shinosawa) to yield predictable results is considered to be obvious (KSR International Co. v. Teleflex Inc., 550 U.S.-, 82 USPQ2d 1385).

Regarding claim 2, the combined device of Wolf, Kitano and Shinosawa discloses in cited figures and related text, **e.g.**, an adhesion layer (Kitano, 110) and a barrier layer (109) are formed, in sequence, on said substrate, with said metal film being formed on said barrier layer.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with an adhesion layer and a barrier layer are formed, in sequence, on said substrate, with said metal film being formed on said barrier layer, in order to form a connection with good thermal conductivity (see Kitano, paragraph 30), and in order to more easily plate the reflecting layer on the underlying layer than directly on substrate (paragraph 22 & paragraph 30), respectively.

Regarding claims 3, 4 & 6, Wolf discloses said metal film is formed as an alloy of at least one of Ag and Al and other metal (page 435, Table 11-1, "Aluminum / 4% Copper), a proportional content of said other metal being 0.001-10 percent by weight, wherein said other metal is at least one type of metal selected from a group consisting of Cu, Mg, Si, Mn, Ti, and Cr.

Regarding claims 7 & 8, the combined device of Wolf, Kitano and Shinosawa discloses in cited figures and related text, **e.g.**, a thermal expansion coefficient of said substrate (50) is 1.times.10.sup.-6/K-10.times.10.sup.-6/K and a thermal conductivity of said substrate is at least 80 W/mK (Shinosawa, Title "Aluminum Nitride"; by Applicant's admission on page 12, lines 11-12, "AlN" meets the above claim limitations).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with a thermal expansion coefficient of said substrate is 1.times.10.sup.-6/K-10.times.10.sup.-6/K and a thermal conductivity of said substrate is at least 80 W/mK, in order to simplify the processing steps of making the device, by taking an advantage of a conventional substrate material with an excellent thermal conductivity (see column 1, lines 44-48).

Regarding claim 9, the combined device of Wolf, Kitano and Shinosawa discloses in cited figures and related text, **e.g.**, a semiconductor light-emitting element mounting member according to claim 1 wherein said semiconductor light-emitting element mounting member is a flat submount (Kitano, see FIG. 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with a semiconductor light-emitting element mounting member according to claim 1 wherein said semiconductor light-emitting element mounting member is a flat submount, in order to use a flip chip type light-emitting element on top of it (see FIG. 3 of Kitano).

Regarding claim 10, the combined device of Wolf, Kitano and Shinosawa discloses in cited figures and related text, **e.g.**, a semiconductor light-emitting element (Kitano, 100) mounted thereto.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with a semiconductor light-emitting element mounted thereto, in order to use the device in an application that requires a light-emitting element.

Regarding claims 12 & 13, Wolf, Kitano and Shinosawa discloses in cited figures and related text, **e.g.**, said substrate is an insulative ceramic that is selected from a group consisting of AIN, Al2O3, SiC, Si3N4, BeO, BN, and insulative Si (see Title; "Aluminum Nitride").

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with said substrate is an insulative ceramic that is selected from a group consisting of AIN, Al2O3, SiC, Si3N4, BeO, BN, and insulative Si, in order to simplify the processing steps of making the device, by taking an advantage of a conventional substrate material with an excellent thermal conductivity (see column 1, lines 44-48).

7. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable Silicon Processing for VLSI Era Volume 1 by Wolf et al ("Wolf"), (JP-2003-209286) by Kitano and (US-6689498) by Shinosawa et al ("Shinosawa") as applied to claim(s) above, and further in view of (US-2004/0004435) by Hsu.

Regarding claim 11, Wolf, Kitano and Shinosawa disclose substantially the entire claimed structure, as recited in claims 1 & 10, except the output of said semiconductor light-emitting element is at least 1 W.

Hsu teaches in FIG. 2 and related text the output of said semiconductor light-emitting element is at least 1 W (paragraph 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Wolf, Kitano and Shinosawa with the output of said semiconductor light-emitting element is at least 1 W, in order to use the device in an application that requires high brightness (see Hsu, paragraph 9).

Response to Arguments

1. Applicant's arguments filed on 10/09/2008 have been fully considered but they are not persuasive.

2. **Regarding claim 1**, the Applicant argues on page 6, second paragraph from the bottom, that the combination of Wolf with Kitano is a result of improper hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

3. Furthermore, as the Applicant has pointed out in his "Applicant's Arguments", the Examiner has agreed to discuss with the Applicant potential amendments to claims. The Examiner has considered potential amendments (by performing a thorough review of the Applicant's disclosure) and found something that appeared promising. Namely, specific values for the surface roughness of the substrate were not disclosed by either Kitano or Wolf (see Applicant's disclosure, page 37; it has two tables which in part specify values for the surface roughness of the substrate). Before calling the Applicant, the Examiner has performed a search to see if amending the claim to recite the surface roughness of 0.08 or less (as is supported by the Applicant's disclosure) would put the application into the state for Allowance. However, when performing the search, the Examiner has found the above cited Shinosawa reference (which cites

the substrate surface roughness of 0.05 or less), and used it in the rejection. At this point the Examiner wishes to give the Applicant the opportunity to review the Shinosawa reference and to formulate a response.

4. The rest of Applicant's Arguments (for example, having to do with the surface roughness of the substrate) are moot in light of new grounds for rejection.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Belousov whose telephone number is 571-270-3209. The examiner can normally be reached on Monday - Thursday 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Nguyen can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Belousov/
Examiner, Art Unit 2894
12/11/2008

/Kimberly D Nguyen/
Supervisory Patent Examiner, Art Unit 2894